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32294 7590 05/01/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
SHEDRICK, CHARLES TERRELL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,453

Applicant(s)

BAJKO ET AL.

Examiner

CHARLES SHEDRICK

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 5-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/11/08 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the at least on parameter ". There is insufficient antecedent basis for this limitation in the claim. Consider the following:the response includes at least one parameter in breach of policy (i.e., parameter A). A network controller detects that the response includes at least one parameter (i.e., parameter A as noted above) breaching the policy, and modifying the at least one parameter (i.e., parameter A). Note that limitation would be clear if only one parameter was involved, however the claim language states at least one meaning the language extends to multiple parameters that could be breaching policy. Therefore, one should consider the following with regard to antecedent: the response includes at least one parameter in breach of policy (i.e., parameter(s) A, B, or C). A network controller detects that the response includes at least one parameter (i.e., parameter(s) A, B, or C as noted above) breaching the policy. However, the network controller now modifies the at least one parameter. The Examiner respectfully notes that it is unclear which parameter the claim language is intended to

modify at least one parameter in breach of policy (i.e., parameter(s) A, B, or C). The controller could actually modify parameters A or B or C in the response or A or B or C being detected.

The parameters in the response and the parameter detected could actually be different parameters based on the claim language and therefore it is unclear as to which parameter the claim intends to modify.

Response to Arguments

The following remarks are added based on the arguments presented by the Applicant in an effort assist the Applicant with the Examiners interpretation of the claim language.

Applicant argues Shaheen fails to disclose or suggest all of the elements of any of the presently pending claims. Claim 1 recites, "modifying, by the network controller, the at least one parameter to be consistent with the policy." Shaheen fails to disclose or suggest at least this feature of claim 1.

3. The Examiner respectfully disagree with the Applicant argument and rationale based on the following: Carefully consider claim 1, A response is simply a reaction. Therefore, since the claim language of claim 1 indicates " a response to the message", Shaheen would still read on the claim since the nodes of Shaheen clearly react accordingly to the message . Carefully consider that nowhere in claim language of claim 1 is the direction of the response explicitly indicated. As noted in the claim language a message goes from a first party to a second party. The message has clear indication of direction, however the claim language is void of who, what or where regarding the sending a response to the message. The Examiner respectfully notes that the claim language simply requires a response (i.e., a reaction) to the message (i.e., not necessarily a path to a particular destination as argued by the Applicant).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **18-39** are rejected under 35 U.S.C. 102(c) as being anticipated by Ejzak et al. US Patent Pub. No.: 2004/0095923 A1(Ejzak).

Consider **claim 18**, Ejzak teaches a method, comprising:
passing a message from a first party to a second party in a communication system (e.g., see **communication flow of figures 10-12**); receiving a response to the message, the response including at least one parameter in breach of a policy for a communication between the first party and the second party (e.g., see **figure 10-12 and at least paragraph offer and answer transaction**); passing the response unmodified from the second party to the first party (e.g., see **figures 10-12 the answer to offer is passed via gateways and controllers from user 122 to 120**); and determining in a network controller that the response includes one or more of said at least one parameter breaches the policy (e.g., see **at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency**).

Consider **claim 21**, Ejzak teaches a controller, configured to: forward a message from a first party to a second party in a communication system (e.g., see **offer/answer message flow of figures 10-12**); forward a response to the message (e.g., see **offer/answer message flow of**

figures 10-12), the response including at least one parameter in breach of a policy for a communication between the first party and the second party(**e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency**); pass the response unmodified from the second party to the first party(**e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency and message flow in figures 10-12**); and determine in a network controller that one or more of said at least one parameter breaches the policy(**e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency**).

Consider **claim 24**, Ejzak teaches a communications system for providing communication sessions between parties connected thereto (see **100 of at least figures 1-9**) , the communication system comprising a controller configured to: forward a message from a first party to a second party in a communication system (**e.g., see offer/answer message flow of figures 10-12**); forward a response to the message, the response including at least one parameter in breach of a policy for a communication between the first party and the second party(**e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency and message flow in figures 10-12**); pass the response unmodified from the second party to the first party (**e.g., see figures 10-12 the answer to offer is passed via gateways and controllers from user 122 to 120**); detect one or more of said at least one parameter in breach of the policy in a further message from the first party(**e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency and message flow in figures 10-12**); and

send to the first party another message containing the policy allowed payload in response to detection of said at least one parameter in breach of the policy(e.g., **see figures 10-12 the answer to offer is passed via gateways and controllers from user 122 to 120**).

Consider **claim 25, 27-28 and 34-35**, Ejzak teaches a method, system and controller in a communication system for handling responses to messages, the method comprising:passing a message from a first party to a second party in a communication system(e.g., **see offer/answer message flow of figures 10-12**); receiving a response from the second party to the first party(e.g., **see offer/answer message flow of figures 10-12**), the response including at least one parameter in breach of a policy for communication between the parties(e.g., **see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency**); determining in a network controller that one or more of said at least one parameter is in breach of the policy(e.g., **see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency**); and sending a further message including a definition of the policy to the first party(e.g., **see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency in connection with message flows in figures 10-12**). Ejzak addresses the SIP/SDP in paragraphs 0023-0024

Consider **claims 30 and 32** Ejzak teaches: passing a message from a first party to a second party in a communication system(e.g., **see offer/answer message flow of figures 10-12**); receiving a response including at least one parameter in breach of a policy for a communication between a first party and a second party(e.g., **see offer/answer message flow of figures 10-12**); passing the response unmodified from the second party to the first party(e.g., **see at least**

negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency and message flow in figures 10-12); sending by the first party a further message including at least one parameter in breach of the policy(e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 in connection with message flows in figures 10-12); and detecting in a network controller that the further message includes at least one parameter breaching the policy(e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 in connection with message flows in figures 10-12).

Consider **claims 36 and 39**, Ejzak teaches a user equipment (e.g., see **120 and 122 as noted in paragraph 0030**), comprising: first sending means for sending a message to a second user equipment (e.g., **mobile phones as noted in paragraph 0030**); receiving means for receiving a response to the message(e.g., **mobile phones as noted in paragraph 0030**), the response including at least one parameter in breach of a policy (i.e., see **offer as noted in paragraph 0064 and figures 10-12 since the users can modify offers with respect to answers**); controller means for modifying at least one parameter into consistency with the policy(i.e., see **controllers in figures 10-12**); and second sending means for sending a further message to a network controller (e.g., see **figure 10-12 a second or alternate offer/ answer based on the session type**), the further message including at least one modified parameter(e.g., see **figure 10-12 a second or alternate offer/ answer from user based on the session type**); wherein the controller means is further configured to further modify the at least one parameter in response to a response to the further message (e.g., see **figure 10-12 a second or alternate offer/ answer from controller based on the session type**).

Consider **claim 19 and as applied to claim 18**, Ejzak teaches the claimed invention further comprising: sending a further message from the first party to the network controller(e.g., **see figure 10-12 a second or alternate offer/ answer from user based on the session type**), said determining comprising detecting at least one parameter in breach of the policy in the further message(e.g., **see figure 10-12 a second or alternate offer/ answer from user based on the session type**).

Consider **claim 20 and as applied to claim 19**, Ejzak teaches the claimed invention further comprising: responsive to said detecting, sending to the first party by the network controller another message containing the policy allowed payload(e.g., **see figure 10-12 a second or alternate offer/ answer from controller based on the session type**).

Consider **claim 22 and as applied to claim 21**, Ejzak teaches the claimed invention configured to detect at least one parameter in breach of the policy in a further message from the first party(e.g., **see at least negotiation discussed in paragraph 0046, 0055, and 0068 in connection with message flows in figures 10-12**).

Consider **claim 23 and as applied to claim 22**, Ejzak teaches the claimed invention configured to send to the first party another message containing the policy allowed payload in response to detection of said at least one parameter in breach of the policy(e.g., **see figure 10-12 a second or alternate offer/ answer from controller based on the session type**).

Consider **claim 26 and 29 and as applied to claims 25 and 28**, Ejzak teaches the wherein the sending of the further message comprises sending information of at least one

parameter in consistency with the policy(**e.g., see at least negotiation discussed in paragraph 0046, 0055, and 0068 the controller checks network address parameters etc for consistency and message flow in figures 10-12).**

Consider **claims 31 and 33 and as applied to claims 30 and 32**, Ejzak teaches the claimed invention further comprising sending a further response including a definition of the policy to the first party(**e.g., see figure 10-12 a second or alternate offer/ answer from controller based on the session type).**

Consider **claim 37 and as applied to claim 36**, Ejzak teaches the claimed invention configured to further modify at least one parameter in response to a response to the further message(**e.g., see figure 10-12 a second or alternate offer/ answer from controller based on the session type).**

Consider **claim 38 and as applied to claim 37**, Ejzak teaches the claimed invention wherein the user equipment is configured to modify the at least one parameter to be consistent with a local policy(**e.g., see figure 10-12 a second or alternate offer/ answer from controller based on the session type).**

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims **1, 3, 5-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. US Patent Publication No.: 2003/0035401 A1 (Shaheen) in view of Ejzak et al. US Patent Pub. No.: 2004/0095923 A1.

Regarding **claims 1 and 9-12**, Shaheen discloses a method and system comprising: sending a message from a first party to a second party in a communication system (**par. 33, and 65**); sending a response to the message, the response including at least one parameter in breach of a policy for a communication between the first party and the second party in a communication system (**pars. 37-39, and 66**); detecting in a network controller that the response includes at least one parameter breaching the policy (**pars. 49, 61-63, 65, 67, and 75-77**); and removing by the network controller, the at least one parameter to be consistent with the policy (**see figure 8 steps s5-s9, pars. 45, 65, and 75 lines 22-24, i.e. S-CSCF removes or reduces a set of supported codecs based on operator policy**).

However, Shaheen does not specifically disclose modifying by the network controller, the at least one parameter.

In analogous art, Ejzak teaches modifying by the network controller, the at least one parameter (e.g., see **paragraph 0043-0044, and 0066**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaheen to include modifying by the network controller, the at least one parameter for the purpose of network negotiations as taught by Ejzak, Ejzak further indicates that the steps could be performed in a differing order.

Regarding **claim 3**, Shaheen as modified by Ejzak discloses a method **as claimed in claim 1**, wherein the modifying comprises modifying the at least one parameter by the first party (par. 45).

Regarding **claims 5-8**, Shaheen as modified by Ejzak discloses the method **as claimed in claim 1**, wherein the detecting comprises detecting in the network controller which provides a call session control function, wherein the detecting comprises detecting in the network controller which provides the call session control function comprising at least one of a proxy call session control function or a serving call session control function, wherein the detecting comprises detecting that the response includes the at least one parameter comprising a parameter of a session description protocol, wherein the sending comprises sending the response being in accordance with a session initiation protocol (see figures 1-9, and pars. 5-7).

Consider **claim 13 and as applied to claim 10**, Shaheen teaches the claimed invention except wherein the controller is configure to pass the response unmodified from the second party to the first party, and check to determine whether a further message from the first party responding to the response includes the at least one parameter in breach of the policy.

In analogous art, Ejzak teaches wherein the controller is configured to pass the response unmodified from the second party to the first party(e.g., see **figures 10-12 the answer to offer is passed via gateways and controllers from user 122 to 120**), and check to determine whether a further message from the first party responding to the response includes the at least one parameter in breach of the policy (e.g., see **figures 10-12 the answer to offer is passed via gateways and controllers from user 122 to 120**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaheen to include wherein the controller is configured to pass the response unmodified from the second party to the first party, and check to determine whether a further message from the first party responding to the response includes the at least one parameter in breach of the policy for the purpose of network negotiations as taught by Ejzak, Ejzak further indicates that the steps could be performed in a differing order.

Regarding **claims 14, and 15**, Shaheen as modified by Ejzak discloses the communication system **as claimed in claim 10**, wherein the controller is configured to provide a call session control function, wherein the controller comprises at least one of a proxy call session control function or a serving call session control function (see **figures 1 and 2, i.e. P-CSCF, S-CSCF**).

Regarding **claim 16**, Shaheen as modified by Ejzak discloses the communication system as claimed **in claim 10**, wherein the controller is configured to detect that the response includes a parameter of a session description protocol (**par. 48 lines 1-3**).

Regarding **claim 17**, Shaheen discloses the communication system as claimed in **claim 10**, wherein the controller is configured to send the response in accordance with a session initiation protocol (**par. 75 lines 22-24**).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harper Paul can be reached on (571)-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Charles Shedrick/
Examiner, Art Unit 2617
April 27, 2008

